

In re Application of: Hibscher *et al.*
Application No.: 09/741,564
Atty Docket No.: 03405.018001

Examiner: A. Enatsky
Art Unit: 3713

REMARKS

By this Response, in the present Application, Claims 14-32 are pending. Claims 1-13 have been previously cancelled.

In the outstanding Office Action, Claims 14-15, 17-18, 20-22, 24, 26, 29-30 and 32 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,102,796 to *Pajitnov*, in view of U.S. Patent No. 5,599,231 to *Hibino et al.*, and further in view of U.S. Patent No. 6,117,061 to *Popat et al.* Further, Claims 16, 23 and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Pajitnov*, in view of *Hibino*, further in view of *Popat*, and further in view of U.S. Patent No. 6,386,543 to *Luker*. Finally, Claims 19, 25 and 27-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Pajitnov*, in view of *Hibino*, further in view of *Popat*, and further in view of Applicants' admissions of Prior Art.

Applicants' attorney would also like to thank the Examiner for the courtesies extended during the Interview that occurred on 14 July 2004. During the Interview, Applicants' attorney and the Examiner discussed the references cited by the Examiner in the outstanding Office Action. Although no agreement as to the substance or patentability of the Claims was reached, Applicants made several arguments concerning the applicability, relevance and analogous-ness of the references (specifically, the *Popat* reference). It was noted that the Examiner would take Applicants' arguments under advisement upon the filing of this Response.

In re Application of: Hibscher *et al.*
Application No.: 09/741,564
Atty Docket No.: 03405.018001

Examiner: A. Enatsky
Art Unit: 3713

Initially, Applicants will present a brief description of the cited references. First, *Pajitnov* describes a system and method for solving puzzles, and, in one embodiment, solving puzzles via the Internet. More specifically, *Pajitnov* is "directed to a system and method for composing an image from fragments of the image." *Pajitnov*, col. 7, lines 11-12. A player is first presented with a fragmented image. The fragments are preferably arranged in a random order. The player then places the fragments in a desired position, forming an image. *Pajitnov*, col. 7, lines 11-44. As noted by the Examiner in the outstanding Office Action, *Pajitnov* does not, however, teach linking a user identifier to either game access or the ability to create, edit or play games, as is required by the Present Invention.

Secondly, *Hibino* describes creating and editing video games; however, *Hibino* does not teach the use of the Internet as a medium from which game creating and editing is to occur. More specifically, *Hibino* provides a floppy disk (on either extensional memory peripheral) to the user, on which software, relating to the game, is stored. After an authorization protocol, the user can then modify a portion of the video game. The modified game may then be saved on the floppy disk. *Hibino*, col. 13, lines 24-54. The portion of *Hibino* that discusses the Internet merely describes playing or transmitting games via the Internet, not creating or editing them.

Third, *Popat* describes software used for the creation of three-dimensional printed structures. In the disclosure, *Popat* teaches that the software may be employed in a remote location. However, the software disclosed in *Popat* only provides for inputting user revisions, and does not provide for the user modification of various aspects of the structures. *Popat*, Summary. Although the software in *Popat* does

In re Application of: Hibscher *et al.*
Application No.: 09/741,564
Atty Docket No.: 03405.018001

Examiner: A. Enatsky
Art Unit: 3713

appear to contemplate online game manipulation, it nevertheless does not provide the control and autonomy as the Present Invention does.

And finally, *Luker* describes a computer program for creating, printing, storing, organizing, solving and publicizing double crostic puzzles and playing a solitaire game based thereon. While *Luker* describes creating crostic puzzles generally, it does not discuss creating and editing crostic puzzles, or any puzzles, via the Internet.

Applicants respectfully assert that the disclosures of *Hibino* and *Popat* both teach away from, and are thus inapplicable to, the Present Invention. Concerning *Hibino*, it is noted above that *Hibino*, after verifying an authorization protocol, allows the user to modify a *portion* of the video game. This is different from the Present Invention, which allows the user to modify the entire puzzle. Thus, it is asserted that this reference teaches away from the Present Invention.

Similarly, concerning *Popat*, it is noted that the Examiner (in both the Office Action and in the Examiner Interview) pointed to *Popat* as evidence of a teaching of an application of the disclosure to user-created puzzles. However, although it discloses the possibility of customized puzzles, *Popat* only provides for the inputting of user revisions, and does not provide for the user modification of various aspects of the structures.

More specifically, in *Popat*, the user would still have to buy pre-perforated printing sheets. By contrast, in the Present Invention, such a limitation is non-existent. Thus, neither *Hibino* nor *Popat* can be said to be completely customizable. Since this aspect is present in the Present Invention, Applicants assert that the cited references teach away from the Present Invention.

In re Application of: Hibscher *et al.*
Application No.: 09/741,564
Atty Docket No.: 03405.018001

Examiner: A. Enatsky
Art Unit: 3713

In sum, none of the aforementioned references individually, or in combination, describe a system or method for creating, editing, playing and allowing selective access to games via an online system. More specifically, vis-à-vis the Claims of the Present Invention, each of the cited references appears to not contemplate the use of online creation of the games; while the references discuss online playing and online editing, they fail to provide for online creation.

Based on the foregoing Remarks, the present Application is considered to be in condition for allowance. Such action on the part of the Examiner is respectfully requested. If the Examiner feels a telephonic conference would expedite the allowance of the present Application, it is suggested the Examiner contact the undersigned Attorney.


It is further believed that an Extension Of Time Fee is due for filing this Response. The Office is authorized to charge this fee, as well as any deficiencies or refund any overpayments, to Deposit Account No. 502261.

In re Application of: Hibscher *et al.*
Application No.: 09/741,564
Atty Docket No.: 03405.018001

Examiner: A. Enatsky
Art Unit: 3713

Respectfully submitted,

Date: 27 September 2004



Timothy M. Morella
Reg. No. 45,277
Attorney for Applicants

NEAL, GERBER & EISENBERG LLP
2 North LaSalle Street
Chicago, Illinois 60602 3801
312 269 8000

Certificate of Transmission under 37 CFR § 1.8: The undersigned hereby certifies that this document is being transmitted to the Commissioner for Patents *via Facsimile* at 703 872 9306, this 27th Day of September, 2004.

By: 

Timothy M. Morella

NGEDOC5: 1081888.1